

REMARKS

Claims 11-19 were rejected under 35 USC § 112 as being indefinite. This rejection is respectfully traversed.

It is believed that the rejection for indefiniteness is moot in view of the cancellation of claims 11-19 and the addition of claims 21 and 22.

The previous claims were rejected under 35 USC § 102(e) as being anticipated by Narang et al., US 5,830,600 (Narang) and Akio et al., JP 10189038 (Akio). These rejections are respectfully traversed.

There is herewith submitted a verified translation of applicants' priority document. Thus, Akio is no longer available as a reference under 35 USC § 102.

Among the numerous solvents for electrolytes disclosed by Narang is tris-(methoxyethyl)phosphate (page 7, line 59). Numerous lithium salts are disclosed, including LiBF_4 , and that lithium salt is not one of those preferred (see col. 10, lines 17-27). In the two working examples that utilize TMEP as solvent, the preferred LiPF_6 is used as the electrolyte salt (see line 7 of Table 1 and line 9 of Table 2).

From the above description of the reference it can readily be seen that to arrive at applicants' claims, one must select one of many solvents disclosed and combine it with one of many electrolyte salts disclosed, and disclosed only as a non-preference. Nothing in any of the specific disclosure, such as the working examples, would have led one to the specific combination recited in applicants' claims. It has long been held

that type of reference represented by Narang can not constitute an anticipation of a claimed invention. See MPEP § 2131. Prior decisions that state clearly that picking and choosing from various parts of even a single reference and combining those parts to result in an applicants' invention is not proper, particularly without specific guidance in the reference. Merely for example, see *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344 (CCPA 1978), *In re Arkley*, 455 F.2d 586, 587-88, 172 USPQ 524, (CCPA 1972), *Ex parte Levy*, 17 USPQ2d 1461, 1463-64 (BPAI 1990).

Claim 13 has been rejected under 35 USC § 103 (a) as being unpatentable over Narang. This rejection is respectfully traversed.

Since claim 13 has been canceled, this rejection is now moot. However, to whatever extent this rejection would be applied to claims 21 and 22, the above discussion is relevant. The fact that applicants' claims cover only non-preferred electrolyte salts and there is nothing in the reference even to suggest their combination with any of the electrolyte solvents recited in applicants' claims, not even a suggestion of applicants' invention can be found in that reference. See MPEP § 706.02(j) and the cases cited therein. With respect to the type of rationale based on logic and sound scientific reasoning required of an examiner in constructing a rejection for obviousness, see *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993). Where, as here, all of the preferences and specific examples disclosed in the reference lead away from what is

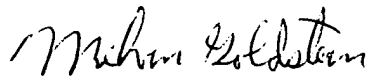
being claimed, it is particularly inappropriate to reach a conclusion of obviousness. *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994), *In re Marshall, supra*. Also see MPEP § 2141.02, last paragraph.

A check in the amount of \$420.00 is attached to cover the required two month extension fee.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

KEIL & WEINKAUF



Melvin Goldstein
Reg. No. 41,560

1101 Connecticut Ave., N.W.
Washington, D.C. 20036
(202)659-0100

MG/kas

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION

Page 1, at indicated line 12, add the heading:

--BACKGROUND OF THE INVENTION--.

Page 4, line 7, add the heading:

--BRIEF SUMMARY OF THE INVENTION--.

Page 9, line 5, add the heading:

--DETAILED DESCRIPTION OF THE INVENTION--

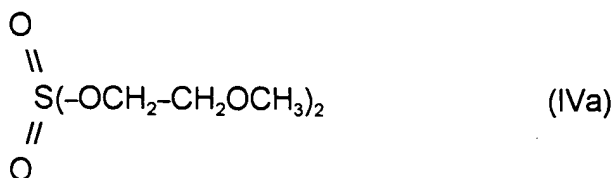
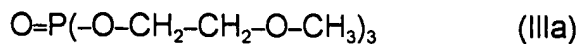
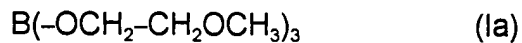
Page 13, line 4, add the heading:

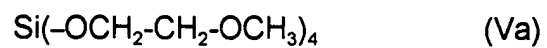
--BRIEF DESCRIPTION OF THE DRAWINGS--.

IN THE CLAIMS

Cancel claims 11-20. Add new claims 21 and 22 as follows:

21. (new) A composition comprising
at least one compound selected from the group consisting of formulae (Ia) to (Va)





and

(B) a conducting salt LiBF_4 or a mixture of LiBF_4 and LiPF_6 with a molar ratio of $\text{LiBF}_4:\text{LiPF}_6$ from 0.1:9.9 to 9.9:0.1.

22. (new) An Li-ion storage cell comprising a composition as defined in claim 21.